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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/763,675

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EXAMINER

CASTELLANO, STEPHEN J

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,675	<b>Applicant(s)</b> SHELSTAD, SCOTT A.	
	<b>Examiner</b> /Stephen J. Castellano/	<b>Art Unit</b> 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 13, 15-20 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 13, 15, 16, 20 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

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The application clearly supports that the clip can be supported on the cup without applying continuous resilient biasing forces to the cup. However, this has not been shown by the drawings. Particularly, Fig. 3C shows that the clip contacts and engages the sidewall in two locations, below the rim on the inner surface of the sidewall and spaced well below the rim on the outer surface of the sidewall. Therefore, Fig. 3C does not support the embodiment claimed in claims 17-19 wherein the attachment portion is configured to engage the rim without application of a continuous, resilient biasing force to the sidewall and the rim.

In addition to the restriction requirement, claims 17-19 are believed to be a different species not shown in a drawing figure because Fig. 3C has a clip which is supported by the sidewall by the application of a biasing force.

Claims 17-19 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and specie, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 28, 2008.

Claims 11, 14, 21 and 22 have been canceled. Claims 1-10, 12, 13, 15-20 and 23-28 are pending. Claims 1-10, 12, 13, 15, 16, 20 and 23-28 will be treated according to their merits.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rim receiving aperture of the attachment portion of the apparatus being configured for engaging the rim as stated in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1-10, 12, 13, 15, 16, 20 and 23-28 are objected to because the drawings do not properly show what is claimed in claims 1, 20 and 23 wherein the rim receiving aperture of the attachment portion of the apparatus being configured for engaging the rim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 12, 13, 15, 16, 20 and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claim 1 states that the rim receiving aperture of the attachment portion is configured for engaging at least part of the enlarged, annular peripheral rim in lines 5 and 6 of

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claim 1. As shown in Fig. 3C, the rim is not engaged by the rim receiving aperture or any other portion of the apparatus. Rather, the sidewall engages the apparatus by frictionally retaining the apparatus as shown in Fig. 3C. Note that the frictional engagement doesn't allow the apparatus to touch the rim at the receiving aperture of the apparatus and that gravity doesn't allow the apparatus to touch the rim. This configuration is claimed by the limitations of claim 10 which states that there is no continuous biasing force on the rim and is supported by the corresponding portions of the written specification.

Independent claims 20 and 23 include similar limitations to the attachment portion being configured for engaging the cup rim that contradict what is shown in the drawing and discussed in the written specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 12, 13, 15, 16, 20 and 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 1 states "an apparatus for use in association with a cup for aiding a user in identifying that cup" and seems more appropriate for a subcombination claim wherein only the apparatus is the subject of the claim. In lines 2 and 3 of claim 1, the elements of the cup are positively claimed. The positively claimed elements of the cup contradict the preamble which state that the apparatus is intended for use with a cup. Claim 1, line 7, states that the attachment portion has an arcuate configuration to at least approximately conform with a portion of the annular opening of the cup. This also contradicts the preamble because the elements of the

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cup are positively claimed. Claim 1, line 9, states that the entrance opening width is less than the rim thickness of the enlarged, annular peripheral rim of the cup. Again, this contradicts the preamble because the elements of the cup are positively claimed. Independent claim 1 is indefinite because it can't be determined if applicant is claiming the combination of a cup and a clip (apparatus) or if applicant is claiming only the clip (apparatus for use in association with a cup).

Dependent claims also add positive limitations that contradict the preamble of claim 1 which states that the apparatus is intended for use with a cup. For example, claim 3, lines 1-3 state positively that the cup has a sidewall, a sidewall thickness and a rim thickness. The positive limitations of: (1) width of the receiving aperture must accommodate the rim thickness and (2) the entrance opening width configured as less than the rim thickness but greater than the sidewall thickness are stated in claim 3.

Independent claim 20 is indefinite for a similar reason as claim 1. The preamble states an intended use, "for use in association with a cup." Yet, lines 2 and 3 recite positive elements of the cup. The identification portion is positioned adjacent to the sidewall of the cup when the attachment portion is in engagement with the rim (see lines 11-13 of claim 20). The protrusion is in non-confronting relationship with any other portion of the apparatus on the opposite side of the sidewall of the cup see last two lines of claim 20).

Claims 1-10, 12, 13, 15, 16, 20 and 23-28 will be treated as claiming the combination of a cup and a clip (apparatus).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 10, 12, 13, 15, 16 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Macaluso, Jr. et al. (3,399,780) (Macaluso).

Macaluso discloses an apparatus in combination with a cup, the apparatus assists in identifying the cup, the cup having an opening defined by an enlarged, annular peripheral rim, the apparatus comprising a body including an attachment portion (20, 22, 24 – the upper inverted U shaped portions which attach to the peripheral rim).

Re rim curvature, the curvature of a rim can extend around an opening in two different directions; (1) a circumferential direction and (2) a direction starting on the interior surface of the cup and extending radially outwardly to end on an exterior surface of the cup.

The attachment portion defines a rim receiving aperture. The attachment portion having an arcuate configuration to at least approximately conform with a portion of the annular opening has the shape of the attachment portion is arcuate in cross section and surrounds the rim portion of the annular opening which rim portion is arcuate in cross section. The attachment portion defines an arcuate entrance opening leading into the rim receiving aperture. The width of the entrance opening is less than the rim thickness.

Re claim 2, the rim receiving aperture is resilient and appropriately sized to be capable of slidably capturing the rim therein because the entrance opening is configured to slide past the enlarged rim.

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Re claim 3, the rim thickness is greater than the sidewall thickness. When the attachment portion is attached to the cup, the entrance opening width is greater than the sidewall thickness but less than the rim thickness.

Re claim 4, the arcuate configuration of the attachment portion is configured to resiliently deform upon passing the rim thickness through the entrance opening.

Re claim 5, the attachment portion is configured to resiliently deform upon flexing of the rim.

Re claim 10, the attachment portion is configured for sliding over the rim with no continuous biasing force on the rim when the attachment portion is frictionally retained in the position shown in Fig. 4 of Macaluso which is similar to Fig. 3C of the present invention.

Re claims 12 and 13, the body includes an identification portion (the outwardly extending portion with a free end, as best shown in Fig. 5 of Macaluso) connected with the attachment portion and positioned proximate to the outside surface of the sidewall when the clip is attached to the cup. Re claim 15, the identification portion is customizable. Re claim 16, the body is formed of plastic.

Re claim 24, the arcuate configuration of the attachment portion has a cross section that is arcuate. This arcuate cross section is configured to conform to a portion of the circumference of the rim that is arcuate in cross section.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Macaluso.

If it should be deemed that Macaluso doesn't disclose the flexing of the rim of the cup. The Official notice taken in the last Office action that plastic and paper cups with enlarged, annular peripheral rims which flex are well known is now being treated as a prior art admission. It would have been obvious to modify the cup to be plastic or paper as these materials are readily available, relatively inexpensive, and do not shatter or break when dropped.

Claims 1-5, 10, 12, 13, 15, 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macaluso in view of Fischer et al. (Fischer) and Myers, Jr. (Myers).

If it should be deemed that Macaluso doesn't disclose the curvature of the attachment portion extending in a circumferential direction around the opening to approximately conform with the rim curvature in a circumferential direction. Fischer discloses a brush bucket which is supported with an attachment portion, the attachment portion has two parts both of which are arcuate to approximately conform to the circumferential curvature of an upper rim of a paint bucket. Myers similarly discloses a paint bucket with an attachment portion with an arcuate curvature to approximately conform to the circumferential curvature of an upper rim of a paint bucket. It would have been obvious to modify the two attachment portions of Macaluso to be arcuate in a circumferential direction to conform better than flat portions or portions not curved in the circumferential direction as motivated by the better fit and easier operation.

Re claim 3, the entrance opening would be arcuate after the above modification.

Claims 6, 20, 23 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macaluso in view of Bauer.

Macaluso discloses an attachment portion with conforming tab and protrusion. Macaluso discloses the invention except for (1) the non-conforming relationship of the first and second portions of the attachment portion (claim 6) (2) the corresponding non-conforming relationship of the protrusion with any other portion of the apparatus (claims 20 and 23) and (3) the corresponding non-conforming relationship of the tab with any other portion of the apparatus (claims 27 and 28). Bauer teaches a similar device to Macaluso which is held in position by a different attachment means.

Re claim 6, the Bauer device teaches an inner periphery adjacent portion D, F (first portion) and an outer periphery adjacent portion E (second portion), the first and second portions are in a non-confronting relationship across the rim. It would have been obvious to modify Macaluso to have a non-confronting relationship added as a matter of design choice in choosing to use additional securing elements to add to the secure fit.

Re claim 20, 23 and 25-28, Bauer teaches a tab (E) and a protrusion (other E) or D, F, both the tab and the protrusion are in non-confronting relationship with any other portion of the apparatus. It would have been obvious to add Bauer's tab and protrusion to the design of Macaluso as a matter of design choice in choosing to use additional securing elements to add to the secure fit.

Claims 6-9, 20, 23 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macaluso in view of Williamson and Bauer.

Macaluso has two spaced apart interior tabs and an exterior protrusion. Macaluso discloses the invention except for the non-confronting relationship. Williamson teaches an attachment portion with two interior tabs spaced equally from an exterior protrusion, wherein

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both of the tabs and the protrusion are in non-confronting relationship. It would have been obvious to modify the configuration of the tabs and protrusions of Macaluso to be configured like Williamson in a non-confronting relationship in order to provide support for an exterior shelf.

If it should be deemed that the tabs and protrusion do not conform to the cross sectional shape of the rim, then Bauer teaches non-confronting tabs or protrusions E which conform to the cross sectional shape of the rim. It would have been obvious to modify the shape of the tabs and protrusions to be arcuate in shape to conform to the shape of the rim to provide a tighter securement to the rim to make the attachment more stable and less likely to slip.

Applicant's arguments filed October 23, 2007 have been fully considered but they are not persuasive. The examiner doesn't agree that the straight clip configuration of the '780 patent to Macaluso is of an explicit nature and of such significance that modification to an arcuate configuration would render the Macaluso device inoperable. Applicant's statements with regard to the inoperability are conclusionary and not based upon any reasonable train of thought. Further, it is believed that the cross section of Macaluso which is arcuate at the attachment portion defines the arcuate configuration insofar as this configuration has been claimed. Macaluso meets this limitation without modification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Stephen J. Castellano/ whose telephone number is 571-272-4535. The examiner can normally be reached on increased flexibility plan (IFP).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony D. Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen J. Castellano/  
Primary Examiner  
Art Unit 3781

sjc